

Remarks

Reconsideration of the subject application in view of the present amendment is respectfully requested.

By the present amendment, claims 10 and 14 have been amended and claim 13 has been canceled.

Based on the foregoing amendments and the following remarks, the application is deemed to be condition for allowance, and action to that end is respectfully requested.

I. Rejection of Claims Under 35 U.S.C. §112.

The Examiner rejected claim 14 under 35 U.S.C. §112, second paragraph, for allegedly being indefinite. Claim 14 has been amended to overcome such rejection. Accordingly, withdrawal of the rejection to such claim and allowance of such claim is respectfully requested.

II. Rejection Over the Prior Art.

The Examiner rejected claims 10 and 12 under 35 U.S.C. §102(b) as being anticipated by Larsen, et al, U.S. Patent No. 6,598,270 (Larsen).

Claims 10-14 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Calabro, U.S. Patent No. 5,954,305 (Calabro) in view of Bailey, U.S. Patent No. 5,566,916 (Bailey). It is respectfully submitted that

the claims 10-14 are patentable over the prior art, including all of the prior art of record in this application.

Larsen refers to an equipment mounting strap for securing equipment like a CPU on an equipment shelf in a rack having side frames. The composite strap include an elastic section (col. 3, lns. 46-50) for securing the equipment, whereby the composite strap is fixed in angled brackets having slots for receiving the composite strap. The brackets will be attached on both legs of the U-shaped side frame (Fig. 3).

In contradistinction, the system for fastening a pipe to a support according to the invention allows fastening a pipe which lays on a horizontal placed support of the support construction crossways to the longitudinal axis of the horizontal placed support (p.6, last par.; Fig.3). According to the given arrangement (e.g. dimensions or arrangement of the pipe or conduit), the bracket elements will be arranged on the support in the desired distance to each other on the same side wall of the support. According to the dimensions and the geometry of the pipe, the appropriate mounting element is used whereby the free ends of the mounting element are passed through the elongated opening of the bracket element and fixed in the desired position using fastening means (p. 7, 1st par.). The conduit fastening system according to the invention is flexible and conduits different in size and different in cross

section can be fixed with this system only by use of the appropriate mounting element.

Larsen does not lead one skilled in the art to arrange brackets for the composite strap on the same side wall of one of the side frames. The elongated openings of the brackets are not made for allowing a continuously slid of a mounting element in the elongated openings of the brackets. Also, if one skilled in the art would have arranged two brackets according to Larsen at one side wall of the frame this would not have lead to the inventive system for fastening a pipe on a support. As mentioned in the application, the mounting element is chosen in accordance with the pipe to be fixed and is essentially U-shaped in a preferred embodiment (p. 7, 2nd par.).

A rejection based on U.S.C. § 102 as in the present case, requires that the cited reference disclose each and every element covered by the claim.

Electro Medical Systems S.A. v. Cooper Life Sciences, 32 U.S.P.Q. 2d 1017, 1019 (Fed. Cir. 1994); Lewmar Marine Inc. v. Barient Inc., 3 U.S.P.Q. 2d 1766, 1767-68 (Fed. Cir. 1987); Verdegaal Bros., Inc. v. Union Oil Co., 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987). The Federal Circuit has mandated that 35 U.S.C. § 102 requires no less than “complete anticipation . . .

[a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim.” Connell v. Sears, Roebuck & Co., 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro

Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros., 2 U.S.P.Q. 2d at 1053.

Since Larsen fails to disclose each and every feature of independent claim 10, Larsen, as a matter of law, does not anticipate the present invention, as defined by said independent claim. In view of the above, it is respectfully submitted that Larsen does not anticipate or make obvious the present invention as defined in claim 10, and claim 10 and claim 12 that depends therefrom is patentable over Larsen.

It is respectfully submitted that claims 10-14 are patentable over Calabro in view of Bailey.

Calabro refers to an antenna mounting platform having an outer hand rail assembly mounted thereon and comprising support tubes mounted to the platform by adjustable brackets (col. 5, lns. 33-51). All the support tubes having the same size and dimensions and thus one type of threaded U-bolt can be used for all connections. A predetermined distance between openings in the brackets is secured with different embodiments of the brackets for passing the free ends of one type of threaded U-bolt therethrough (Fig. 6, Fig. 10).

Bailey discloses an adjustable pipe brace for supporting a pipe or a pole against a support surface. As shown in Figure 6, a support plate has a pair of

wings, a pair of extension plates and a base, whereby the wings are coplanar and the legs of a U-bolt pass through slotted holes in the wings. The U-bolt can be adjusted left and right in a small range. There is no suggestion for one skilled in the art to divide the disclosed support plate into two pieces and change them analogous to the bracket elements according to the invention.

Moreover, in Bailey, the use of such modified brackets for fastening a conduit on a support according to the invention is not obvious.

Further, the two piece brackets of Calabro are designed to complement one another to create a mounting with a U-shaped bracket.

Moreover, if one skilled in the art had taken the disclosures of Bailey and Calabro and combined them this would not have lead to the claimed invention. If one skilled in the art would arrange the elongated slots according to Bailey on the brackets of Calabro such a combination would lead him to a mounting for an edge of a structure which allows a horizontal adjustment of the piece that shall be fixed by this mounting. This virtual mounting differs from the invention, as recited in claim 10 and claims 11-14 that depend therefrom. Neither Calabro nor Bailey show a system for fastening a pipe comprising at least two brackets whereby each bracket is formed as an angular (L-shaped) element having a first member securable to the profile section having a plurality

of openings formed in the outer wall and spaced from each other at a predetermined distance, and a second member which extends at an angle (approximately 90°) to the first member and having at least one elongated opening that extends in a mounted condition of the bracket parallel to the longitudinal axis of the profile section or as originally claimed parallel to the alignment means for orienting the bracket.

Under MPEP § 2143 *prima facie* case of obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that the first element of *prima facie* obviousness has not been established.

“obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir 1992) (footnote omitted) (emphasis in original). See also *In re Sernaker*, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Fine*, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

There is no suggestion, incentive or motivation in the cited references for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness.

MPEP §2143.01 relying on *Ex Parte Levengood*, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993). In order to establish a *prima facie* case of obviousness, “it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggesting incentive or influence in the prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have been led to combine the relevant teachings.” *Id.* At 1301 (emphasis in original).

The Court of Appeals for Federal Circuit has held that a claimed invention was not obvious, where “[c]onspicuously missing from [the] record as any *evidence*, other than the PTO’s speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art “necessary to arrived at the claimed invention. *In re Jones* 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992).

Ex Parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App & Inter. 1985) requires that when the references do not suggest the invention “. . . the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references.” No such line of reasoning is seen in the Office Action.

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or template to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

In the *In re Fritch* holding only confirmed a long established view that obviousness should not be read “into an invention on the basis of Applicants’ own statements”, that the prior art must be viewed “without reading into that art Appellant’s teachings”, and that the teachings of the prior should, “in and of themselves and without the benefits of Appellant’s disclosure (emphasis in the original text) make the invention as a whole, obviously.” *In re Sponnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969). It is respectfully submitted that the teachings of the prior art does not make the present invention obvious.

The Court of Appeals for the Federal Circuit has consistently ruled that it is not permissible to use hindsight to reject a claim.

As pointed out in *Uniroyal v. Redkin-Willey*, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988):

When prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.

There is nothing in the prior art that would suggest combining such references to achieve the claimed invention.

In view of the above, it is respectfully submitted that none of the references alone or in combination make the present invention, as defined in claim 10, obvious, and the present invention is patentable over such references.

Claims 11-14 depend on claim 10 and are allowable for the same reasons claim 10 is allowable, and further because of specific features recited therein which, when taken alone and/or in combination with features recited in claim 10, are not disclosed or suggested in the prior art.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in

formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



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